Supreme Court, U.S.
FILED

941075 DEC 19 1994

OFFICE OF THE CLERK

In The
Supreme Court United States
October Term, 1994

BRUNSWICK CORPORATION,
Petitioner,

v.

BRITISH SEAGULL LIMITED and OUTBOARD MARINE CORPORATION,
Respondents.

Petition For Writ of Certiorari To The United States Court of Appeals For the Federal Circuit

TIMOTHY J. HALLER*
MICHAEL P. MAZZA
NIRO, SCAVONE, HALLER & NIRO
181 West Madison, Suite 4600
Chicago, IL 60602
(312) 236-0733

Attorneys for the Brunswick Corporation

**Attorney of Record*

Chicago Legal Copies, Inc. (312) 332-7777

88 pp

QUESTION PRESENTED

1. Is the "functionality" test applied more expansively to color trademarks than to other types of federal trademarks?

STATEMENT PURSUANT TO RULE 29.1

The only parties to this action are those listed in the caption. Brunswick Corporation has no parent or subsidiary companies, defining "subsidiary" as greater than 50% ownership (and excluding wholly owned subsidiaries).

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
STATEMENT PURSUANT TO RULE 29.1	ii
TABLE OF AUTHORITIES	v
OPINIONS BELOW	2
JURISDICTION	2
STATUTORY PROVISIONS INVOLVED	3
15 U.S.C. § 1052 (Lanham Act, Sec. 2) Trademarks Registrable on Principal Register	3
15 U.S.C. § 1057 (Lanham Act, Sec. 7) Certificates of Registration	8
15 U.S.C. § 1119 (Lanham Act, Sec. 37) Powers of Court Over Registration	9
15 U.S.C. § 1127 (Lanham Act, Sec. 45) Construction and Definitions	9
STATEMENT OF THE CASE	11
I. BACKGROUND	11
II. PROCEEDINGS BELOW	13
III. PRELIMINARY STATEMENT IN VIEW OF PENDING QUALITEX CASE	15
REASONS FOR GRANTING THE PETITION	15
I. THE DECISION OF THE FEDERAL CIRCUIT IS IN DIRECT CONFLICT WITH THE INWOOD DECISION OF THE SUPREME COURT	15

II. THE FEDERAL CIRCUIT DECISION RELEGATES COLOR MARKS TO A "SECOND CLASS" STATUS AMONG TRADEMARKS . . 17

CONCLUSION 20

TABLE OF AUTHORITIES

Page(s)

CASES

In re Bose Corp., 772 F.2d 866, 227 U.S.P.Q. 1 (Fed. Cir. 1985) 14

Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221 (CCPA 1976) 17

Inwood Lab., Inc. v. Ives Lab., Inc., 456 U.S. 844 (1982) 14

Qualitex Company v. Jacobson Products Co., Inc., 63 U.S.L.W. 3255 (Sept. 26, 1994) 15

Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576 (Fed. Cir. 1984) 17

28 U.S.P.Q. 2d 1197 (T.T.A.B. 1993) 2

STATUTES

15 U.S.C. § 1052 (Lanham Act, Sec. 2) 3, 11

28 U.S.C. § 1254(1) 2

Sections 2, 7(b), 37 and 45 of the Lanham Act, 15 U.S.C. §§ 1052, 1057(b), 1119, and 1127 3

15 U.S.C. § 1057 (Lanham Act, Sec. 7). . 8

15 U.S.C. §§1063, 1070 3

15 U.S.C. § 1071(a)(1) and 1295(a)(4)(B) 2

15 U.S.C. § 1119 (Lanham Act, Sec. 37) 9

15 U.S.C. § 1127 (Lanham Act, Sec. 45) 9

No.

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1994

BRUNSWICK CORPORATION,

Petitioner,

v.

BRITISH SEAGULL LIMITED
and OUTBOARD MARINE CORPORATION,

Respondents.

**PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

Petitioner, Brunswick Corporation ("Brunswick" or alternatively "Mercury"), respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit ("Federal Circuit") in this case.

OPINIONS BELOW

The opinion of the Federal Circuit is reported at 35 F.3d 1527 and is reprinted as Appendix A, A1-28. The opinion of the United States Patent & Trademark Office, Trademark Trial and Appeals Board ("the Board") is reported at 28 USPQ2d 1197 (T.T.A.B. 1993) and is reprinted as Appendix B, A29-65. The Notice of Publication of Mercury's trademark registration application by the Trademark Examiner is reprinted as Appendix D, A69-70.

JURISDICTION

The Federal Circuit entered its judgment on September 14, 1994 (App. A, A1). Brunswick petitioned for rehearing on September 28, 1994. The petition was denied on October 24, 1994 (Appendix C, A66-68). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). The Federal Circuit had jurisdiction over the appeal from the Board under 15 U.S.C. § 1071(a)(1) and 1295(a)(4)(B). The Board had subject matter

jurisdiction over the underlying oppositions under 15 U.S.C. §§ 1063, 1070.

STATUTORY PROVISIONS INVOLVED

The statutes involved in this petition are Sections 2, 7(b), 37 and 45 of the Lanham Act, 15 U.S.C. §§ 1052, 1057(b), 1119, and 1127, which provide:

15 U.S.C. § 1052 (Lanham Act, Sec. 2) Trademarks Registrable on Principal Register.

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it --

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Commissioner

determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in

the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, or (4) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a), (b), (c), (d), and (e)(3) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods

in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the clam of distinctiveness is made.

* * *

15 U.S.C. § 1057 (Lanham Act, Sec. 7) Certificates of Registration.

....

(b) Certificate as Prima Facie Evidence.

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive

right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate subject to any conditions or limitations stated in the certificate.

* * *

15 U.S.C. § 1119 (Lanham Act, Sec. 37) Powers of Court Over Registration.

In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

* * *

15 U.S.C. § 1127 (Lanham Act, Sec. 45) Construction and Definitions.

. . . .

The term "trademark" includes any word, name, symbol or device, or any combination thereof --

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

STATEMENT OF THE CASE

Following the allowance by the United States Trademark Examiner of Mercury's registration application, the Federal Circuit affirmed the Board's decision sustaining the consolidated oppositions to registration of Mercury's color trademark.

I. BACKGROUND

Mercury has continuously manufactured and sold outboard marine engines in the color black for over thirty years. In 1962, Mercury introduced its first all black outboard engine. Since 1964, all Mercury outboard engines have been black. In the last three decades, Mercury has spent over $100 million in advertising and generated $3 billion in sales of its all black outboard motors. It is undisputed that Mercury advertisements have focused on Mercury's "all black" color.

On April 27, 1988, Mercury filed an application to register the color black for outboard engines on the Principal Register. Relying on 15 U.S.C. § 1052(f), Mercury

maintained that the color black, while perhaps not inherently distinctive, had acquired secondary meaning and served as a trademark for Mercury's outboard engines. The Trademark Examiner allowed the registration (App. D, A69-70). British Seagull Ltd. and Outboard Marine Corp. ("OMC") (the "opposers") filed Opposition Nos. 80,900 and 80,901 which were consolidated by the Board.

It is undisputed that opposer Outboard Marine Corp. (OMC) has been the unit volume leader in the manufacture and sale of outboard marine engines from the early 1980's to the present (Appellate Appendix, A11939-943). OMC has maintained a 47.35% average market share for the years 1981 to 1990 as compared to Mercury's 20% share (A11939-943) -- and there is no evidence in the record that OMC ever sold a single all black engine as a standard commercial product in the more than 75 years it has been in the business.

Mercury presented uncontradicted evidence, including two surveys, showing that its "all

black" trademark has acquired secondary meaning as a result of its long and exclusive use. The opposers proffered no survey evidence. However, the Federal Circuit's decision does not substantively address secondary meaning (App. A, A27). Instead, it affirms the Board's decision based solely on the "functionality" issue as it applies to Mercury's color trademark.

II. PROCEEDINGS BELOW

The Board found the color black de jure functional because of competitive need, stating:

> [A]lthough the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors.

(App. B, A35). Opposers proffered no direct testing or survey evidence of prospective purchaser users on color compatibility or "objects colored black appear smaller." The Federal Circuit affirmed solely on the basis of the perceived presence of functionality due to

competitive need (App. A, A27), and quoted the test articulated by the Supreme Court:

> In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. Inwood Lab., Inc. v. Ives Lab., Inc., 456 U.S. 844, 850 n. 10 (1982). (Emphasis added).

(App. A, A8). The Federal Circuit then stated:

> Contrary to Mercury's assertion, **the test for de jure functionality does not involve inquiry into whether a particular feature is "essential" to compete at all:**
>
> > If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its de facto purpose, it follows that competition is hindered. Morton-Norwich does not rest on total elimination of competition in the goods.
>
> In re Bose Corp., 772 F.2d 866, 872, 227 USPQ 1, 6 (Fed. Cir. 1985).

(App. A, A11-12) (bold emphasis added, underlined emphasis in original).

III. PRELIMINARY STATEMENT IN VIEW OF PENDING QUALITEX CASE

Petitioner concedes that this petition must be summarily denied if the first "Question Presented" before this Court in Qualitex Company v. Jacobson Products Co., Inc., 63 U.S.L.W. 3255 (Sept. 26, 1994) is answered in the affirmative -- namely "Whether the Lanham Act prohibits the registration of color as a trademark?" If color alone is subject to trademark registration, however, this Petition is believed to raise a significant issue concerning whether color trademarks may be treated in a manner fundamentally different from other types of trademarks registrable under the Lanham Act with respect to functionality.

REASONS FOR GRANTING THE PETITION

I. THE DECISION OF THE FEDERAL CIRCUIT IS IN DIRECT CONFLICT WITH THE INWOOD DECISION OF THE SUPREME COURT

The Inwood test for functionality requires that in order for a product feature to be functional, it must either: 1) be "essential" to the use or purpose of the product; or 2)

affect the "cost or quality" of the product. Here, the Board clearly found that Mercury's "all-black" color does not affect the "cost" or "quality" of the outboard engines to which it is applied:

> [T]he color black is not functional in the sense that it makes these engines work better [quality], or that it makes them easier or less expensive to manufacture [cost]....

(App. B, A35). The Federal Circuit did not disturb this finding (App. A, A13) ("The color black, as the Board noted, does not make the engines function better as engines. The paint on the external surface of an engine does not affect its mechanical purpose.").

The alternative inquiry under Inwood is whether Mercury's "all-black" color is "essential" to the "use or purpose" of the outboard engines. Neither the Board nor the Federal Circuit made any such finding. Nor could they: OMC's domination of the outboard engine market -- achieved by selling only non-black engines as standard product offerings -- clearly and obviously shows otherwise. How

could OMC be so successful if "all black" was so essential?

The Board's "functionality" conclusion was clearly erroneous. Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 1578 (Fed. Cir. 1984) (Board's determination of functionality reviewable for clear error). The Federal Circuit's decision to affirm is clearly in error unless some unarticulated functionality test unique to color trademarks applies. Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221, 1224-25 (CCPA 1976) (Factual findings underpinning a judgment must be based on some credible evidence). In short, barring a contrary result in Qualitex, the law does not allow the Board and the Federal Circuit to circumvent Inwood and exempt color trademarks from the "essential to use or purpose" inquiry.

II. THE FEDERAL CIRCUIT DECISION RELEGATES COLOR MARKS TO A "SECOND CLASS" STATUS AMONG TRADEMARKS

The Board's conclusion that engine manufacturers have a "competitive need" to use Mercury's "all black" trademark, based on its

"color compatibility" and "objects colored black appear smaller" statements, shows that it treated Mercury's color trademark in a manner at odds with the Supreme Court's instructions in Inwood. Despite stating that the record was one of the "largest ever" before it (App. B, A33), the Board never specifically cited to the record to support its "color compatibility" and "objects colored black appear smaller" statements (App. B, A34-65). All the credible evidence adduced before the Board suggested otherwise. There was no evidence in the record suggesting Mercury's "all black" mark is "essential" for effective competition. Neither the Board nor the Federal Circuit decisions suggests otherwise. The ability to register any color as a trademark will be near impossible if a competitor can simply say that he may have a "competitive need" to use it also.

In short, both the Federal Circuit and the Board treated Mercury's color trademark like a "second class" mark, not entitled to the standards of registration and review that other

types of trademarks receive under the Lanham Act. The Federal Circuit's treatment of Inwood will breed unending functionality disputes with respect to color trademarks. Therefore, a decision in favor of Qualitex in the Qualitex case will suggest that this Petition should be granted. It would further appear appropriate to consolidate this Petition, if granted, with the Qualitex case, since both appellate decisions clearly treat color trademarks in a materially different fashion than other types of trademarks.

CONCLUSION

For the reasons set forth above, a writ of certiorari should issue to review the judgment and opinion of the Federal Circuit.

Dated: December 14, 1994

Timothy J. Haller*
Michael P. Mazza
NIRO, SCAVONE, HALLER
& NIRO
181 West Madison Street
Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Attorneys for Petitioner
Brunswick Corporation

*Attorney of Record

BRUNSWICK CORPORATION, Appellant, v. BRITISH SEAGULL LIMITED and OUTBOARD MARINE CORPORATION, Cross-Appellants.

BRUNSWICK CORP. v. BRITISH SEAGULL LTD.

94-1049,-1050

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

35 F.3d 1527; 1994 U.S. App. LEXIS 25150; 32 U.S.P.Q.2D (BNA) 1120

September 14, 1994, Decided

SUBSEQUENT HISTORY: Rehearing Denied and In Banc Suggestion Declined

October 24, 1994, Reported at: 1994 U.S. App. LEXIS 30952.

PRIOR HISTORY: Appealed from: U.S. Patent and Trademark Office Trademark Trial and Appeal Board. (Opposition No. 80,900 & 89,901).

COUNSEL: Timothy J. Haller, Niro, Scavone, Haller & Niro, of Chicago, Illinois, argued for appellant. With him on the brief were John C. Janka and Michael P. Mazza. Of counsel were Raymond P. Niro, Samuel L. Alberstadt and Raymond P. Niro, Jr.

Robert E. Clemency, Michael, Best & Friedrich, of Milwaukee, Wisconsin, argued for cross-appellants. With him on the brief was Lee J. Geronime.

JUDGES: Before MAYER, RADER, and SCHALL, Circuit Judge.

OPINION BY: RADER

OPINION: RADER, Circuit Judge.

The Mercury Marine division of Brunswick Corporation appeals the decision of the Patent and Trademark Office's Trademark Trial and Appeal Board (Board) sustaining Opposition Nos. 80,900 and 80,901. British Seagull Ltd. v. Brunswick Corp., 1993 TTAB LEXIS 21, 28

U.S.P.Q.2D (BNA) 1197 (TTAB 1993). The Board refused to register the color black as a mark for Mercury's outboard motors. Because the color black is de jure functional in this instance, this court affirms.

BACKGROUND

Mercury has manufactured and sold marine outboard engines for over thirty years. In 1962, Mercury introduced its first all black outboard engine. Since 1964, all Mercury outboard engines have been black. * In the last three decades, Mercury has spent over $ 100 million in advertising and generated $ 3 billion dollars in sales of its outboard motors. Some of Mercury's advertisements focused on Mercury's "all black" color. Mercury engines were not, however, the only black outboard engines on the market during that time. British Seagull Ltd., Sears, Roebuck & Co., and Outboard Marine Corp. also produced black engines or dark engines virtually indistinguishable from black.

- - -Footnotes- - - - - - - - - - - - - - -

* The Board noted that although Mercury seeks registration of its "all black" engine color, Mercury has never sold an all black engine devoid of any other colors or markings. Indeed, the engines have contained striping decals and the "MERCURY" trademark. However, the Board treated Mercury's proposed mark as the color black irrespective of lettering or decals also appearing on the engines. This court will do likewise.

- - -End Footnotes- - - - - - - - - - - - - -

On April 27, 1988, Mercury filed an application to register the color black for outboard engines on the Principal Register. Relying on 15 U.S.C. @ 1052(f) (Supp. V 1993), Mercury claimed that the color black, while not inherently distinctive, acquired secondary meaning and served as a trademark for Mercury's outboard engines. The Examining Attorney allowed the registration. British Seagull Ltd. and Outboard Marine Corp. (the opposers) filed Opposition Nos. 80,900 and 80,901. Upon motion

of the parties, the Board consolidated the oppositions.

The Board considered the proposed mark's functionality:

Although the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors. The evidence shows that people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels, and that they also find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats.

British Seagull, 28 U.S.P.Q.2D (BNA) at 1199. The Board concluded that the color black,

applied to the engines, is de jure functional because of competitive need.

The Board next ruled on evidentiary matters. The Board refused to consider materials which Mercury submitted to the Examining Attorney to show registrability under 15 U.S.C. @ 1052(f) because they were not part of the record in the inter partes opposition proceeding. The Board also denied the opposers' request to exclude some of Mercury's evidence: Harold Exhibit 5, DuCoty Exhibits 1 & 2, the Mantis survey, Mellenthien Exhibit 253, Piper Exhibits 2 through 6, and related testimony.

On the merits of distinctiveness, the Board held that Mercury did not show secondary meaning. Mercury presented, inter alia, a survey (the Mantis survey) in which 73% of the respondents associated black outboard engines with a single source. The Board found that this survey did not show that black was a source indicator for Mercury goods.

The Board also found that Mercury's use of black on outboard engines was not exclusive. Several of Mercury's competitors in the outboard market had engines colored black or dark colors easily perceived as black. Moreover, Mercury contributed to third party use of black on outboards by supplying an all black engine to an independent retailer for resale to the general public.

The Board concluded that Mercury's all black color for outboard engines was not registrable. Mercury appeals from the Board's decision holding that the color black applied to its engines is de jure functional and without secondary meaning. The opposers cross-appeal the Board's decision to admit Harold Exhibit 5, DuCoty Exhibits 1 & 2, the Mantis survey, Mellenthien Exhibit 253, and Piper Exhibits 2 through 6.

ANALYSIS

I. De jure Functionality

A.

A trademark is "any word, name, symbol, or device, or any combination thereof" used by a marketer "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. @ 1127 (1988). A trademark protects only features which are not functional. Textron, Inc. v. United States Int'l Trade Comm'n, 753 F.2d 1019, 1024, 224 U.S.P.Q. (BNA) 625, 628 (Fed. Cir. 1985). "In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." Inwood Lab., Inc. v. Ives Lab., Inc., 456 U.S. 844, 850 n.10, 72 L. Ed. 2d 606, 102 S. Ct. 2182 (1982). Such functional features cannot receive trademark protection.

Like any other mark, the use of color -- if functional -- cannot serve as a trademark. In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1120-21, 227 U.S.P.Q. (BNA) 417, 419 (Fed. Cir.

1985). When "the color applied to goods serves a primarily utilitarian purpose it is not subject to protection as a trademark." Id. Functionality is a question of fact, In re Morton-Norwich Products, Inc., 671 F.2d 1332, 1340, 213 U.S.P.Q. (BNA) 9, 15 (CCPA 1982), and depends upon the totality of the evidence, Owens-Corning, 774 F.2d at 1120. A determination of functionality is reviewed for clear error. See Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 1578, 222 U.S.P.Q. (BNA) 665, 666 (Fed. Cir. 1984). This court does not reweigh the evidence to decide anew whether the applicant's mark is functional. See id. at 1579. Rather, this court "accepts the [Board's] factual findings unless they are clearly wrong." Id.

B.

Functionality reflects a tension between two fundamental principles of trademark law. See Morton-Norwich, 671 F.2d at 1336-37. On the one hand, "there exits a fundamental right to

compete through imitation of a competitor's product, which right can only be temporarily denied by the patent or copyright laws." Id. at 1336. Because trademark protection is potentially perpetual in duration, protection of a functional trademark would defeat that fundamental right. On the other hand, the functionality doctrine also reflects the individual's right to protect symbols which identify the source of particular goods. Id. at 1337. In sum, the right to protect a product feature serving as a source indicator is limited by "the need to copy [articles which are not protected by patent or copyright], which is more properly termed the right to compete effectively." Morton-Norwich, 671 F.2d at 1339 (emphasis in original).

In balancing these two policies, this court acknowledges a distinction between de facto functional features, which may be entitled to trademark protection, and de jure functional features, which are not:

In essence, de facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid. De jure functionality, on the other hand, means that the product is in its particular shape because it works better in this shape. In re R.M. Smith, Inc., 734 F.2d 1482, 1484, 222 U.S.P.Q. (BNA) 1, 3 (Fed. Cir. 1984) (citations omitted) (quoting Morton-Norwich, 671 F.2d at 1338). Thus, merely labeling a design feature as functional will not necessarily defeat registrability. In re Teledyne Indus., Inc., 696 F.2d 968, 971, 217 U.S.P.Q. (BNA) 9, 11 (Fed. Cir. 1982). Rather, de jure functionality rests on "'utility,' which is determined in light of 'superiority of design,' and rests upon the foundation [of] . . . 'effective competition.'" Morton-Norwich, 671 F.2d at 1340.

Contrary to Mercury's assertion, the test for de jure functionality does not involve inquiry into whether a particular feature is "essential" to compete at all:

If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its de facto purpose, it follows that competition is hindered. Morton-Norwich does not rest on total elimination of competition in the goods.

In re Bose Corp., 772 F.2d 866, 872, 227 U.S.P.Q. (BNA) 1, 6 (Fed. Cir. 1985) (emphasis added).

In sum, the "crux" of the distinction between de facto and de jure functionality -- determining eligibility for trademark protection or not -- is a design's effect on competition. Morton-Norwich, 671 F.2d at 1341. Thus, the policies underlying the functional limitation on trademark protection explicitly invoke an inquiry into competitive fairness. Therefore, the Board did not err by basing its finding of de jure functionality on competitive need.

C.

Turning to the present case, the Board determined that "black, when applied to

[Mercury's] outboard marine engines, is de jure functional because of competitive need." British Seagull, 28 U.S.P.Q.2D (BNA) at 1199. The color black, as the Board noted, does not make the engines function better as engines. The paint on the external surface of an engine does not affect its mechanical purpose. Rather, the color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller. With these advantages for potential customers, the Board found a competitive need for engine manufacturers to use black on outboard engines. Based on this competitive need, the Board determined that the color was de jure functional. This court discerns no error in the Board's legal reasoning and no clear error in its factual findings.

This court's decision in Owens-Corning does not compel a different result. In Owens-Corning, Owens-Corning sought to register the color pink as applied to its fibrous glass insulation. This court reversed the Board's refusal to register

the color pink as Owens-Corning's trademark. The Board found that no other insulation manufacturer colored any of its products. The record revealed no reason to dye the insulation pink or any other color. Indeed, insulation in use is not open to general view at all. Owens-Corning alone undertook the additional, unnecessary step of coloring the insulation.

This court determined that no anti-competitive effects would follow from awarding Owens-Corning a mark for the color pink. Owens-Corning, 774 F.2d at 1123. Rather, the color served the "classical trademark function of indicating the origin of the goods," id. at 1123:

> We agree with the Board that the color "pink" has no utilitarian purpose, does not deprive competitors of any reasonable right or competitive need, and is not barred from registration on the basis of functionality.

Id. at 1122.

This case, as the Board found, compels a different result. All outboard engine manufacturers color their products. These manufacturers seek colors that easily coordinate with the wide variety of boat colors. The Board found that the color black served this non-trademark purpose. In addition, the Board found that the color black serves the non-trademark purpose of decreasing apparent object size. The record showed that these features were important to consumers. Unlike the pink color in Owens-Corning, the Board found a competitive need for the color black. Thus, the Board concluded that registration of Mercury's proposed mark would hinder competition. This court discerns no clear error in the Board's findings.

D.

In evaluating competitive need, the Board correctly stated:

When we consider whether a color is functional we must consider whether alternative colors are

available in order to avoid the fettering of competition. If competition will be hindered, the color in question is de jure functional. British Seagull, 28 U.S.P.Q.2D (BNA) at 1199. This approach harmonizes with Morton-Norwich:

> Since the effect upon competition "is really the crux of the matter," it is, of course, significant that there are other alternatives available.

Morton-Norwich, 671 F.2d at 1341 (citation omitted). Cf. Bose, 772 F.2d at 866 ("This case [in which the utilitarian nature of a five-sided housing for a five-sided mechanism has been established] is unlike Morton-Norwich where 'an infinite variety' of container shapes remained available to competitors.").

The Board also referred to the color depletion theory, which acknowledges "a limited number of colors in the palette, and that it is not wise policy to foster further limitation by

permitting trademark registrants to deplete the reservoir." Owens-Corning, 774 F.2d at 1120.

While disavowing in Owens-Corning the color depletion theory as a per se rule, this court nevertheless recognized its applicability in appropriate circumstances:

[The color depletion] theory is not faulted for appropriate application, but following passage of the Lanham Act courts have declined to perpetuate its per se prohibition which is in conflict with the liberating purposes of the Act.

Id. (first emphasis added). The functionality limitation on trademark protection properly subsumes any lingering policy concerns embodied in the "color depletion theory." The theory is not a per se bar to registration of color marks. Rather, traditional trademark policies, including the functionality limitation, set the boundaries for color mark registration. Thus, if the use of color on the applicant's goods serves a non-trademark purpose that hinders

competition, the de jure functionality doctrine precludes trademark protection. Only in that sense does the "color depletion theory" have any viability. Accordingly, the Board did not erroneously apply a color depletion theory to deny registration to Mercury's proposed mark.

E.

In In re DC Comics, Inc., 689 F.2d 1042, 215 U.S.P.Q. (BNA) 394 (CCPA 1982), the Court of Customs and Patent Appeals specifically rejected the notion that purely aesthetic features can in themselves confer utilitarian functionality on a proposed mark. At issue were drawings of Superman, Batman and Joker as trademarks for the applicant's toy dolls. The Board refused to register the proposed mark because, inter alia, the drawings were mere artistic renditions of the dolls and shared commercially functional features of "'customary dress, accoutrements, and facial expression'" with the dolls. Id. at 1043 (quoting Board opinion). This court's predecessor reversed:

[The Board] basically mislabeled as 'utilitarian' the ornamental features common to both the dolls and appellant's drawings, there being no engineering advantage conferred upon the dolls by the features involved here. We find no merit in the argument that, by virtue of the aesthetic features identified by the board, appellant's drawings are unable to perform as trademarks for toy dolls.

Id. at 1045. In DC Comics, the court thus held that the aesthetic aspects of the applicant's drawings did not preclude registrability. A concurring opinion explained:

It is arguable that there is no "doctrine" of aesthetic functionality which stands alone, without consideration of the more traditional source identification principles of trademark law. To the extent that there may be -- at least with respect to ex parte prosecution practice -- it has been previously rejected by this court.

Id. at 1050.

DC Comics stands for the proposition that aesthetic ingredients to commercial success are not necessarily de jure functional. Rather, traditional trademark principles govern the registrability of a proposed mark's aesthetic features. As with any mark, the test for de jure functionality hinges on whether registration of a feature hinders competition, and not whether the feature contributes to the product's commercial success.

In Owens-Corning, this court appeared to invoke the doctrine of aesthetic functionality: In Deere & Co. v. Farmhand, Inc., 560 F. Supp. 85, 217 U.S.P.Q. (BNA) 252 (S.D. Iowa 1982), aff'd, 721 F.2d 253 (8th Cir. 1983) [per curiam], the court refused to enforce the color "John Deere green" as a common law trademark for a front-end loader on the bases that the color green was "aesthetically functional" in that purchasers wanted their farm equipment to match, and that secondary meaning had not been established. Such conditions limit an

applicant's right to register a color for its goods, in order to prevent the appropriation of functional product features from the public domain. We thus consider whether the color "pink" [as applied to Owens-Corning insulation] may be so characterized.

Owens-Corning, 774 F.2d at 1121. A review of this commentary in context, however, shows that Owens-Corning did not revive the per se doctrine of aesthetic functionality rejected in DC Comics. Rather this court applied traditional trademark principles, including consideration of competitive factors, in assessing de jure functionality. See id. at 1122-23. Its reference to Deere & Co. merely reaffirmed this court's commitment to analyzing registrability in terms of effect on competition. See Deere & Co., 560 F. Supp. at 95, 98 (noting that the determinative question regarding functionality is "whether protection against imitation of the feature will hinder the competitor in competition," and finding that "protection of

John Deere green and the features that are common to both products would hinder Farmhand in competition").

In this case, the Board did not improperly deny registration to Mercury merely because black served purely aesthetic functions. Color compatibility and ability to decrease apparent motor size are not in this case mere aesthetic features. Rather these non-trademark functions supply a competitive advantage. The Board properly analyzed Mercury's use of black in terms of its non-trademark functions and its effect on competition. Indeed, the Board specifically distinguished its de jure functionality analysis from the doctrine of aesthetic functionality:

In the case at hand we are presented not with a design or configuration which is ornamental or simply more beautiful, but rather with a color which should be available for use by all manufacturers of these products because they need to use it to compete effectively.

British Seagull, 28 U.S.P.Q.2D (BNA) at 1199. In sum, the Board analyzed Mercury's use of the color black according to the law governing the functionality limitation on trademark protection. Additionally, the Board made no clearly erroneous factual findings. Therefore, this court affirms the Board's decision that Mercury's application of the color black to the exterior surface of its outboard engines is de jure functional.

II.

Mercury asserts that the Board erred by failing to consider its offer to limit its application to a specific, well-defined shade of black under 37 C.F.R. @ 2.133(b) (1993). This shade, "Mercury black," allegedly embraces "three dimensional quantitative lightness/chroma/ hue content specifications." Mercury's offer to amend consists, in toto, of the following passage found in its Response Brief, filed before the Board in response to the Opposers' Main Brief:

To the extent that the Board is concerned with the issues of color depletion or shade confusion, Mercury is willing to technically limit the range of its mark. This potential limitation can be considered by the Board under 37 C.F.R. @ 2.133(b).

The Board declined to rule explicitly on the offer to amend.

Section 2.133 provides:

(a) An application involved in a proceeding may not be amended in substance . . . except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board or except upon motion.

(b) If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the roceeding is not entitled to registration in the absence of a specified estriction to the involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file

a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party. 37 C.F.R. @ 2.133(a), (b). Mercury did not obtain the opposers' consent or Board approval, and did not file a motion to amend. Thus, section 2.133(a) does not compel the Board to address Mercury's offer. Under section 2.133(a), the Board did not err in evaluating the application as it was published for opposition. See Peopleware Sys., Inc. v. Peopleware, Inc., 226 U.S.P.Q. (BNA) 320, 321 n.2 (TTAB 1985). Section 2.133(b) also does not compel the Board to address Mercury's offer. Section 2.133(a) applies to amendments during the course of inter partes proceedings before the Board. Section 2.133(b), however, applies only to "restrictions" pertaining to the identification of goods and services in the application. Thus, section 2.133(b) does not apply where the applicant seeks to amend the

description of the mark. Furthermore, even assuming section 2.133(b) does apply here, Mercury has filed no motion or included any affirmative pleading in its answer. Therefore, the Board had no duty to address Mercury's offer to amend. See Personnel Data Sys., Inc. v. Parameter Driven Software, Inc., Cancellation No. 18,719, 1991 TTAB LEXIS 26, * 5 (TTAB Sept. 13, 1991).

III. Acquired Distinctiveness

Under 15 U.S.C. @ 1052(f), marks which have become distinctive of the applicant's goods in commerce may, in proper circumstances, receive trademark registration. However, "evidence of distinctiveness is of no avail to counter a de jure functionality rejection." R.M. Smith, 734 F.2d at 1484-85. See also New England Butt Co. v. United States Int'l Trade Comm'n, 756 F.2d 874, 877, 225 U.S.P.Q. (BNA) 260, 262 (Fed. Cir. 1985)("'One who seeks to register (or protect) a product or container configuration as a trademark must demonstrate that its design is

'nonfunctional' . . . and that the design functions as an indication of source, whether inherently so, because of its distinctive nature . . . or through acquisition of secondary meaning.'" (quoting Morton-Norwich, 671 F.2d at 1343)(alteration in original)). Because the Board correctly applied the functionality limitation to preclude registration, Mercury may not register the color black as applied to the exterior surface of its outboard engines. Therefore this court need not reach the issue of acquired distinctiveness.

IV. Admissibility of Evidence

The opposers cross-appeal, arguing that the Board erred by refusing to exclude certain evidence on grounds of hearsay and inadequate foundation. The Federal Rules of Evidence govern inter partes proceedings before the Board. 37 C.F.R. @ 2.122(a) (1993); Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 1575-76, 6 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1988). Any alleged error in admitting evidence is not

reversible unless the opposers establish prejudice. See id. at 1582; Stock Pot, 737 F.2d at 1581. In light of its rulings on the merits, this court has "no reason to fault the Board's consideration of that evidence, especially since [the opposers have] not shown prejudice to [them] from that consideration." Stock Pot, 737 F.2d at 1581.

AFFIRMED

British Seagull Limited v. Brunswick Corporation
Outboard Marine Corporation v. Brunswick Corporation

Opposition No. 80,900 to application Serial No. 73/724,973, filed April 27, 1988
Opposition No. 80,901 to application Serial No. 73/724,973, filed April 27, 1988

Trademark Trial and Appeal Board
July 30, 1993; November 12, 1992, Hearing
Before Rooney, Cissel and Quinn, Members.

COUNSEL: Robert E. Clemency of Michael, Best & Friedrich for British Seagull Limited and Outboard Marine Corporation.

Timothy J. Haller of Niro, Scavone, Haller & Niro for Brunswick Corporation.

OPINION BY: CISSEL

OPINION: Opinion by Cissel, Member:

On April 27, 1988 Brunswick Corporation filed an application n1 to register the mark shown below on the Principal Register for "internal combustion engines for boats," claiming first use in November 1963.

n1 Serial No. 73/724,973.

[SEE ILLUSTRATION IN ORIGINAL]

By amendment applicant noted that "(t)he mark consists of the color black as applied to the entire surface of the goods" and claimed registrability under Section 2(f) of the Trademark Act based on an allegation of twenty-four years of substantially continuous and exclusive use of the color black on its goods. Applicant further stated with respect to the drawing that "the phantom outlining of the configuration of the goods forms no part of the mark(,) but is merely intended to show position." Also by amendment, applicant specified "outboard marine engines" as its goods. The essence of applicant's claim is that the color black, as applied to outboard engines

for boats, serves as applicant's trademark. Applicant submitted evidence which persuaded the Examining Attorney that the color had acquired distinctiveness and that black identified applicant as the source of marine outboard engines.

Following publication of the mark, two oppositions were filed. Opposition 80,900 was timely brought by British Seagull Limited, and Opposition No. 80,901 was timely filed by Outboard Marine Corporation (hereinafter "OMC"). The two proceedings were consolidated by stipulation of the parties prior to the trial because both plaintiffs take the same position, that black should not be registered as applicant's trademark for these products, and both opposers have produced outboard engines which are black.

As grounds for opposition, opposers assert that since before applicant's claimed first use of what it claims to be its trademark, opposers have manufactured, advertised and sold outboard

motors which are painted black or a dark color which is not visually distinguishable from black; that other makers of marine engines have also sold black outboard motors; that the color black alone cannot function to identify applicant's goods and distinguish them from the goods of others; that the color black cannot be exclusively appropriated by applicant or anyone else as a trademark for outboard motors; that manufacturers and distributors of such products have a competitive need to use black on these goods; that applicant made misrepresentations of material fact to the Patent and Trademark Office during the prosecution of this application; n2 and that applicant has not established and cannot establish that the color black has become distinctive of applicant's outboard motors.

n2 This pleaded ground was not supported with either further argument or any evidence, so the Board has not considered opposers to have continued to assert it.

The record in this proceeding is one of the largest ever submitted for consideration by the Board. The parties do not appear to dispute the basic description of the record as presented in opposers' brief (the testimony, exhibits and the evidence made of record by notices of reliance take six typed pages just to list, and include over three thousand pages of testimony, as well as over eighteen hundred exhibits). Objections to various materials abound, however. The objections will be discussed as the various evidential materials are mentioned in connection with the pleaded issues.

Notwithstanding the daunting size of the record and the extremely contentious adversarial conduct of counsel for the parties in this proceeding, the fundamental issues to be resolved by the Board are not great in number. Basically, we must determine whether the color black, as used by applicant on its goods, has met the standards for registration under the Lanham Act. Based on careful consideration of

the evidence before us, the established legal precedents on this subject, and the arguments presented by the parties, we find that black is de jure functional as applied to marine outboard engines, and that, notwithstanding some degree of recognition in the marketplace that applicant makes black engines, the color black and other colors not readily distinguishable from black have been used on these types of products made and sold by several other business entities, so that black has not become distinctive of applicant's goods and therefore is not registrable as a trademark for applicant's goods. The facts supporting our reasoning are not seriously disputed, and they are discussed below as they apply to each issue.

Opposers pleaded and argued that the color black cannot function as a source indicator for applicant's goods to distinguish them from others because other manufacturers of these kinds of products have used black and other dark colors and have a competitive need to color

their goods black. There is considerable evidence offered to support opposers' argument that although the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors. The evidence shows that people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels, and that they also find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats.

Opposers argue that there is therefore a competitive need for other manufacturers to produce these goods in the color black in order to meet consumer demand. Opposers are trying to

keep applicant from exclusive appropriation of a feature, a particular color, which has as its characteristic that it makes outboard engines more saleable in the marketplace for these goods because the appearance created by the color is more desirable from the perspective of prospective purchasers.

In In re Owens-Corning Fiberglass Corporation, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985), the Court extended trademark protection to a single color for a product, holding that a traditional rationale for precluding registration was inapplicable to the facts of that case. The theory held not to apply there was the color depletion theory, which is that because of the finite number of colors available, to allow manufacturers to monopolize certain colors would hinder competition. Although the Court found this theory inappropriate in that case based on those facts, it acknowledged that color depletion could be a factor to consider under appropriate

circumstances. See also: Kasco Corp. v. Southern Saw Service, Inc. USPQ 2d , (TTAB 1993). The Board noted subsequently in Edward Weck Inc. v. IM Inc., 17 USPQ2d 1142 (TTAB 1990), that when we consider whether a color is functional we must consider whether alternative colors are available in order to avoid the fettering of competition. If competition will be hindered, the color in question is de jure functional.

This de jure functionality must be distinguished from the disfavored concept of aesthetic functionality. See: In re DC Comics, Inc., 689 F.2d 1042, 215 USPQ 394 (CCPA 1982). In the case at hand we are presented not with a design or configuration which is ornamental or simply more beautiful, but rather with a color which should be available for use by all manufacturers of these products because they need to use it to compete effectively.

The demonstrated advantages that black provides to purchasers of these products, are

confirmed by the evidence that many different sources provide black engines or engines in dark colors which may be difficult to distinguish from black. We therefore hold that black, when applied to applicant's outboard marine engines, is de jure functional because of competitive need. If applicant were permitted to appropriate exclusively a particular color which makes these goods more marketable, competitors who could not color their products with similar colors would be at a competitive disadvantage. This is not a situation like the one in Owens-Corning, where no other maker of the product in question colored the goods. Here all other makers of outboard marine engines use one color or another. To limit their options by allowing applicant exclusive appropriation of one of the most marketable colors would be unfair.

Given our holding that black as applied to outboard marine engines is de jure functional because of the competitive need to use it or

other similar colors, applicant may not register black as its trademark. Moreover, even if registration of black were not barred for this reason, then because colors are not inherently distinctive, applicant would still have had to establish that black has acquired secondary meaning as an indicator of applicant as the source of these goods, and applicant has not proved that this is so.

The instant case is distinguishable from In re Deere & Co., 7 USPQ2d 1401, (TTAB 1988). In that case, the colors sought to be registered were conceded by the Examining Attorney to have acquired secondary meaning as indicating source in that applicnat, and there was no evidence that competitors had any need to use that applicant's color scheme in order to compete effectively.

The facts concerning applicant's use of the color black on outboard engines for boats are not seriously disputed. Applicant has produced Mercury outboard engines in only one color,

black, since 1964. n3 The record establishes that sales and promotion of applicant's black Mercury engines have been extensive. Over a hundred million dollars worth of advertising has assisted applicant in making sales of three billion dollars worth of black Mercury engines since 1964. Approximately one of every five outboard engines sold during the 1980's was a Mercury engine. The record clearly supports the conclusion that Mercury has been a major player in this field of commerce for a long time, and that Mercury engines have been sold only in the color black for almost thirty years.

n3 It is interesting to note that applicant's claim is that the entire surface of its engines is black. The testimony and evidence make it clear, however, that the "MERCURY" trademark and various striping decals are exceptions to this claim. Applicant has never sold an all black engine. Notwithstanding this admitted fact, however, opposers have not pleaded that registration is improper because applicant has

never used the mark it claims. We have therefore proceeded as if applicant's claim is that its trademark is the color black as applied to the surface of outboard engines except where stripes and the "MERCURY" trademark appear over the color black. The essence of applicant's contention is clear: that applicant is recognized as the source of black outboard engines irrespective of the word marks or decorative stripes which also appear on such products.

Applicant acknowledges that the color of a product per se is not inherently distinctive, and has accordingly sought to establish that black has acquired secondary meaning as applied to outboard marine engines as a result of extensive and substantially exclusive use and promotion by applicant. Applicant has attempted to show this secondary meaning in several different ways.

Before proceeding with the merits of the claim of distinctiveness, we must clarify a

number of questions regarding the evidence we have considered. To begin with, during the ex parte phase of the prosecution of this application, applicant submitted materials which persuaded the Examining Attorney that the color had acquired secondary meaning. Numerous exhibits, affidavits, and a market survey convinced the Examining Attorney to publish the mark for opposition. These materials, with the exception of those made of record otherwise in this inter partes proceeding (in connection with testimony or by proper notices of reliance), have not been considered by the Board. While the application file is automatically part of the record in an opposition proceeding by means of Trademark Rule 2.122(b), the allegations made, and documents and other things filed in connection with the application, are not evidence in the inter partes proceeding on behalf of the applicant. See: Kellogg Co. v. Pack'em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 21 USPQ2d 1142 (Fed. Cir. 1991);

McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989). Accordingly, the materials submitted only in the ex parte effort to establish registrability under Section 2(f) of the Act were not considered in reaching our decision in this opposition proceeding.

The evidence submitted in this proceeding, as noted above, is voluminous, and most of it relates to whether or not the color sought to be registered has acquired secondary meaning. Opposers have objected to much of the testimony and other evidence which applicant asserts support its claim. The Mantis survey is a key element of applicant's case. To a lesser extent are the testimony and/or associated exhibits of Harold, Mellenthien, Piper, DuCoty, Rowe, Cook, Borst and Matuschka.

Opposers argue that the Mantis survey is flawed in any event, but the essence of opposers' objections to the large body of evidence concerning secondary meaning is that applicant's responses to various discovery

requests of opposers did not reveal applicant's intention to offer this evidence, but instead, mentioned only the application file. It is therefore asserted that these responses of applicant to discovery should have the effect of precluding applicant from introducing at trial any evidence which was not included with or referred to in the application file.

Opposers specifically refer to Interrogatories 31, 49, 50, 53 and 54. Copies of these inquiries and applicant's responses to them were made of record by opposers' March 4, 1992 notice of reliance. With the exception of Interrogatory 31, which related to likelihood of confusion, these interrogatories concerned the witnesses and evidence applicant intended to use at trial in order to attempt to establish that the color black has become distinctive of its goods. Applicant's responses to these interrogatories contained objections on the grounds that they were unduly broad, burdensome,

cumulative, attorney-client privileged, or were subject to work product immunity.

Ordinarily, when a party simply fails to respond to discovery requests, that party is subsequently barred from introducing evidence which was properly requested by its opponent. Weiner King, Inc. v. Wiener King Corp., 615 F.2d 512, 204 USPQ 820 (CCPA 1980). In the case at hand, however, applicant gave a partial answer and otherwise objected to opposers' requests. Applicant's answers and objections indicated that it would use a great deal of additional evidence, but that disclosure of all of it would be burdensome, etc.

A party is not required to disclose the entirety of its proposed evidence in support of its case during discovery. See: Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989); Polaroid Corp. v. Opto Specs, Ltd., 181 USPQ 542 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974). Even if opposers' discovery

requests had been proper, in circumstances where discovery is unreasonably cumulative, duplicative, or unduly burdensome, it will be limited. See: Micro Motion Inc. v. Kane Steel Co. Inc., 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990), and FRCP 26(b)(1).

Applicant could have simply declined to answer opposers' interrogatories on the ground that it was not required to specify in detail the evidence it intended to present at trial. Instead, applicant provided some answers and objected to other questions on the grounds that the interrogatories were cumulative, burdensome, etc. Responsive to applicant's objections, opposers could have moved to compel more complete responses, or might have modified the requests so as to avoid applicant's objections. In view of the underlying impropriety of the interrogatories, in the absence of such actions by opposers, and in light of the outstanding objections by applicant, opposers will not now be allowed to claim that they were unfairly

surprised that applicant has more evidence than that which was presented in the ex parte phase of the prosecution of this application. Opposers' objections to applicant's evidence of secondary meaning on the basis that such evidence was not produced responsive to discovery are therefore overruled. We have considered this evidence.

Additional objections to the testimony and/or exhibits of Harold, Mellenthien, Piper, DuCoty, Rowe, Cook, Borst, and Matuschka are made by opposers on a variety of grounds. Lack of foundation, failure to provide underlying documentation for either testimony or exhibits, improper assertion of privilege, and the aforementioned failure to make disclosures responsive to discovery requests were some of the bases for opposers' objections. Applicant argues, among other things, that opposers failed to pursue their objections promptly.

Apart from the arguments and the particular merits of each of these objections, even when we give these materials our full consideration and consider them to establish the facts which they are asserted to prove, all they do is shed some light on the reasons why some people know that applicant makes black outboard marine engines. As discussed in more detail below, recognition of this fact is not inconsistent with sustaining this opposition. Accordingly, the Board has considered the objected-to testimony and exhibits as if they were not improper.

Opposers additionally criticize the Mantis survey on a basis which is different from the procedural objection based on the discovery responses. Opposers contend that this study, which applicant commissioned during the course of this proceeding, does not establish that the color black has acquired secondary meaning as an indicium of the source of applicant's engines. The testimony of opposers' witness Robert Sorensen, a well-known survey expert, raises

questions as to whether the conclusions reached by Mr. Mantis are based on a survey which is "fatally flawed." Opposers assert that the survey responses were based on aided awareness.

The Mantis interviewers questioned owners of outboard engines or prospective owners of them outside boat shows. Interviewees were shown a photo of a Mercury outboard engine, but the photo had been touched up to remove the striping and the trademark "MERCURY," leaving the engine entirely black. Interviewees were asked whether they associated the color of the engine with one particular company or with more than one company. Those who responded that they associate the color with one particular company were then asked who they believed manufactured the engine.

Opposers contend that the photo used to stimulate responses provided additional information to those interviewed because of the size, shape, and configuration of the engine, and that these factors skewed the responses in

favor of applicant's position. Opposers argue that the interviewers should not have used a photograph at all, but rather should simply have asked whether the interviewee was familiar with outboard motors, and if so, what outboard motor manufacturer, if any, makes black ones. Opposers also challenge the Mantis survey based on the fact that Mr. Mantis did not personally attend or supervise the interviews, and that the interviews were conducted right outside boat shows wherein applicant's black engines may have been extensively displayed and promoted. The crux of all of opposers' arguments concerning the survey is that the interviewees may have had their awareness of applicant as the source of black engines aided or increased by the way the survey was conducted.

As applicant notes, citing T.J. McCarthy, Trademarks and Unfair Competition, (2d ed. 1984) @ 32.50 at 779, it is "notoriously easy" for one survey expert to tear apart the work of another. Even with this in mind, however, applicant

attaches great significance to the fact that opposers did not conduct their own survey in an attempt to avoid the alleged pitfalls of the Mantis survey.

Opposers clearly had no such obligation. The ultimate burden of establishing secondary meaning is always on an applicant. Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, (Fed. Cir. 1988). Moreover, even if the words proposed by Mr. Sorensen were to be used in another survey in an effort to satisfy opposers, opposers could still challenge that survey based on the contention that use of the word "black," instead of a graphic stimulus colored black, might skew the results in light of applicant's use of the word as part of its registered trademark "BLACK MAX" and as part of the name of a fictitious character named BLACK MAX who has been used in promoting and advertising applicant's products.

We recognize the practical difficulty in creating and conducting a survey on this issue

which could not be subject to at least some retrospective criticism, but even if we were to resolve the issue of whether the Mantis survey was based on aided awareness in favor of applicant, we would nonetheless have to conclude that the survey does not establish that black has acquired secondary meaning as an indication of applicant as the source for all black engines.

The problem we have with the survey is that while the survey does establish that a large portion of interviewees are aware that applicant makes black outboard marine engines, the survey does not provide convincing proof that these people believe that all black engines come from the same source. The interviewees in the survey were presumably not well versed in the legal significance trademark lawyers would attach to the phrase "associate with one particular source." We think it is likely that when these consumers responded affirmatively that they associated the color black with one particular

company, what they were communicating was that they could recall only one company that made black engines, rather than that they were able to name more than one such company. In fact, they may have known only one company which made outboard marine engines at all, irrespective of what color paint they bear. Even if the former were the case, i.e., that the question was interpreted as asking if they could identify a maker of black outboard engines, the affirmative responses at best would support the conclusion that a majority of those surveyed knew that applicant makes black engines. That interviewees could recall that applicant makes black engines is not surprising in light of applicant's sales and advertising, its market share, and the length of time that it has sold black engines.

Applicant has sold large numbers of its engines in a wide variety of sizes for almost thirty years in only one color: black. As noted above, applicant has spent over a hundred

million dollars advertising its engines, all of which have been black, and three billion dollars worth of these products have been sold. This extensive presence in the marketplace is bound to create recognition of the fact that applicant's engines are black. The evidence also shows that while applicant is not the exclusive purveyor of black outboard engines, applicant is responsible for the majority of them. That a large portion of the relevant purchasing public knows applicant makes black engines is understandable under these circumstances. Applicant would have us conclude that its large market share and extensive advertising showing black engines has created secondary meaning for the color as a source indicator, but the evidence of applicant's use and promotion of the color explains only why a large portion of those interviewed in the Mantis survey knew that applicant makes black engines. This evidence does not prove that these people believe that all black engines come from

applicant or from any single source. It proves only that responsive to the survey question, they could name applicant as a maker of black engines.

Moreover, applicant's evidence of the advertising of its goods does not convince us that black functions as a trademark for applicant's outboard engines. This evidence does include an excellent example of advertising specifically promoting black in connection with applicant's engines. The advertisement shown on the first three pages of applicant's brief is a textbook example of how to promote a color as a trademark. This copy was taken not from printed advertisements which were published in magazines or newspapers in general circulation or which were circulated to boaters in general, however, but rather was taken from applicant's 32-page 1986 catalogue, so its effect on the entire range of prospective purchasers of outboard engines is not as great as might otherwise have been the case. Although applicant claims that

distinctiveness is also established by the fact that it has consistently shown its black engines in all of its other advertising, such activity does little to support the distinctiveness claim for the color without language in the advertisements specifically touting the color as a source indicator. We note also that applicant has shown its goods in colors other than black in some of its advertisements.

In summary, based on applicant's relatively small amount of promotion of the color as a trademark, we cannot conclude that the advertising activities of applicant have created secondary meaning for black as applicant's trademark.

Several other factors also lead us to conclude that black as applied to the outside of marine outboard motors has not acquired secondary meaning indicating applicant as the source of all black engines. To begin with, the record establishes significant use on engines by others, of black and colors which are so close

to black that they are unlikely to be distinguished from black. Applicant itself is responsible for some of this, in that it manufactured black engines for sale by a retail merchant under the merchant's own trademark, and a subsidiary of applicant has sold black engines under the subsidiary's own mark. When the party which claims that matter has become distinctive of its goods is faced with use by others of the same or similar matter on the same goods, that party has a difficult burden to meet. Levi Strauss & Co. v. Genesco, Inc., 840 F.2d 1579, 222 USPQ 939 (Fed. Cir. 1984). When such a party has sold its own goods, bearing a color which it asserts has become distinctive of its goods, to third parties for resale to the consuming public as the products of those third parties, such practice detracts even further from the alleged distinctiveness of the color as that party's trademark. Edward Weck Inc. v. IM Inc., 17 USPQ2d 1142 (TTAB 1990).

The record shows not just that other black and near-black engines made by others have been on the market, but it also explains that possible reasons for this include the appearance benefits discussed above.

Turning back to the use by others of black and colors unlikely to be distinguished from black, we note that opposer Seagull has continuously advertised and sold primarily black outboard motors in the United States since 1960, which antedates applicant's use of the color black on its engines by several years. Applicant argues that Seagull's sales are de minimis and that Seagull's engines have been only mostly black, with some parts either left unpainted metal or painted, but not painted black. While the presence in the U.S. market of Seagull's engines has not been great and the engines in question are not entirely black, Seagull's sales here are not insignificant, and these engines must be considered to be primarily black, if not entirely black.

A much more significant use of the color black on outboard engines has been by Sears, Roebuck & Co., the nationwide retailer which has sold marine outboard engines through its department stores and also has sold them by means of mail-order catalogues. Like applicant, Sears has sold engines which are black over the entire outer surface except for the trim and the word used as a trademark. Sears has sold black outboard engines since 1982, and sales and advertising of them has been extensive. They are offered in a range of power outputs, from 1 1/2- to 15-horsepower, and compete directly with the lower-powered range of Mercury engines.

Of particular note is the fact that although Sears' name and the "GAMEFISHER" trademark appear on these engines, applicant is one of three different manufacturers (along with Eska and Tanaka) which have supplied "GAMEFISHER" outboard motors to Sears. Applicant's subsidiary, U.S. Marine Corp., which manufactures "FORCE" brand outboard motors,

provided black engines to Sears for sale under the trademark of Sears. In other words, applicant not only is not the exclusive user of black on such goods, it has actually itself contributed to the widespread use of the color, by a competitor, by producing black motors which are sold by Sears without any reference to applicant as the manufacturer of them. Such action by applicant is plainly contrary to applicant's claim of substantially exclusive use.

The record also establishes not only that opposer OMC has produced, promoted and sold black or dark colored engines, including "dark metallic charcoal" ones (the JOHNSON GTs), but also that OMC has produced for Tracker, one of the largest sellers of boat/motor/trailer packages, black engines which bear the marks "TRACKER/JOHNSON" and "TRACKER/EVINRUDE."

In summary, the record shows that during the same time that applicant has used only black on its engines, there has been extensive use of

black and closely-related dark colors n4 by others in the same market, and that some of these engines were actually produced by applicant for others to sell under their own marks. In the face of this third-party use, the claim of substantially exclusive use by applicant does not hold up. As the Court noted in Levi Strauss & Co. v. Genesco, Inc., supra., (at 940 and 941): "When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness upon which purchasers may rely is lacking under such circumstances." We reiterate that applicant has further diminished the alleged distinctiveness by itself manufacturing some of those black engines sold by others under their own trademarks.

n4 The parties elicited testimony and provided argument concerning differences and similarities among a range of dark colors from

"gunmetal grey," "charcoal," and "dark metallic charcoal," to dark blues and browns, etc. There is sufficient evidence of record for us to conclude that, putting semantics aside, there are a number of hues and shades which are not easily distinguishable, particularly from distances of greater than a few feet or in less than optimal lighting.

The extensive use by others of the feature sought to be registered not only diminishes the credibility of applicant's claim of distinctiveness, it gives credence to our interpretation of the Mantis survey. It would be unreasonable for such a large portion of prospective purchasers to attribute all black outboard engines to applicant in the face of the established use of black, and colors indistinguishable from black, by others.

Each party argues that its position in this proceeding is supported by In re Owens-Corning Fiberglass Corporation, supra. We agree that that case enunciates the principles upon which

the case at hand must be decided. In Owens-Corning the color pink was shown to have become distinctive of insulation made by the applicant based on the record of extensive and exclusive use and promotion of the color pink by the applicant. Significant factual differences in the case at hand lead us to a different conclusion here. As opposed to the instant situation, where all outboard engines are painted one color or another, and many have been sold by others in the same color sought to be registered by applicant, in the Owens-Corning case there was no need to color insulation at all, and no other maker of fiberglass insulation had used pink or any other color on its product. The Court specifically acknowledged that color performed no nontrademark function for insulation. Additionally, coloring insulation pink not only added an additional step and concomitant costs to the insulation manufacturing process, it did not result in a product which was more visually appealing or

more advantageous to the purchaser of it. Here the record establishes not only that engines colored black and related dark colors are more marketable, but also that such colors are widely used by others. In the Owens-Corning case, based on a record which established absolute exclusivity of use, with no use of any color whatsoever by any competitor, and with tremendous amounts of promotion directed specifically at associating the color of those goods with that applicant, the Court agreed that registration was appropriate, emphasizing that the case had been decided on its own particular factual record. In the case at hand, the facts established by the record are so different that application of the same legal reasoning results in the opposite conclusion.

Notwithstanding that consumer recognition of the fact that applicant makes black engines has been demonstrated, because of use by others of the same or closely related dark colors, some of which use was on products which applicant itself

made to be sold under the trademarks of others, registration to applicant would not be proper. Accordingly, even if the color black were not de jure functional because other manufacturers use, have used, and need to use black and other colors which are not readily distinguishable from black in order to compete effectively, applicant has failed to prove acquired distinctiveness for the color black in light of its widespread use on goods attributed to sources other than applicant. The oppositions are accordingly sustained and registration to applicant is refused.

United States Court of Appeals

for the Federal Circuit

94-1049,-1050

BRUNSWICK CORPORATION,

Apellant,

v.

BRITISH SEAGULL LIMITED

and OUTBOARD MARINE CORPORATION,

Cross-Appellants.

O R D E R

United States Court of Appeals

for the Federal Circuit

O R D E R

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on October 31, 1994.

FOR THE COURT,

FRANCIS X. GINDHART, CLERK

Dated: October 24, 1994

By Diane M. Frye \s\
Diane M. Frye
Chief Deputy Clerk

cc: TIMOTHY J. HALLER
ROBERT E. CLEMENCY

Filed
U.S. Court of Appeals
for the Federal Circuit
Oct 24, 1994
Francis X. Gindhart
Clerk

BRUNSWICK CORP V. BRITISH SEAGULL, 94-1049
(PTO - 80,900 & 80,901)

Note: Pursuant to Fed.Cir.R. 47.6, this order is not citable as precedent. It is a public record.

Patent and Trademark Office

Assistant Secretary and Commissioner

of Patents and Trademarks

Washington, D.C. 20231

(File Stamp)

89 FEB 24 A11:42

NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:	2. Mark:
73/724,973	Miscellaneous Design
3. Applicant:	4. Publication Date:
Brunswick Corporation	Mar. 21, 1989

The mark of the application above identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13 of the Statute

or by rules 2.101 and 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained at $9.50 each for domestic orders, or at $11.88 each for foreign orders from:

The Superintendent of Documents
U.S. Government Printing Office
Washington, D.C. 20402

By direction of the Commissioner.

CERTIFICATE OF SERVICE

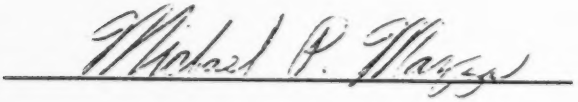
The undersigned hereby certifies that three copies of the foregoing **PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT** were served via First Class Mail, postage prepaid on this 14th day of December, 1994 on the below listed counsel:

Robert E. Clemency
Michael, Best & Friedrich
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202

(Counsel for Respondents)

Fred E. McKelvey
2121 Crystal Drive
Suite 918
Arlington, Virginia 22202

(Counsel for the Commissioner of Patents and Trademarks)



Supreme Court, U.S.
FILED
JAN 17 1995
OFFICE OF THE CLERK

(2)

No. 94-1075

IN THE SUPREME COURT OF THE UNITED STATES

October Term, 1994

BRUNSWICK CORPORATION,
Petitioner,

v.

BRITISH SEAGULL LIMITED
and OUTBOARD MARINE CORPORATION,
Respondents.

On Petition For Writ of Certiorari
To The United States Court of Appeals
For the Federal Circuit

BRIEF IN OPPOSITION

Robert E. Clemency, Esq.*
Lee J. Geronime, Esq.
R. Warren Comstock, Esq.**
Michael, Best & Friedrich
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

Attorneys for
British Seagull Limited and
Outboard Marine Corporation

**Attorney of Record*
***Of Counsel*

41 pp

QUESTION PRESENTED

The question presented by the Petition erroneously assumes that the Trademark Trial and Appeal Board applied a more expansive "functionality" test to Petitioner's application for a color trademark than is applied to other types of federal trademark applications. As appears hereafter, respondent submits that the functionality test(s) applied by the Trademark Trial and Appeal Board, as affirmed by the Federal Circuit, is in accord with Inwood Laboratories v. Ives Laboratories, 456 U.S. 844 (1982).

In addition, the question presented by the Petition also raises (Rule 14.1(a)) the subsidiary question of the admissibility of the evidence which has been objected to by Respondents and which has been offered by Petitioner

through Mr. DuCoty with respect to market share and with respect to Respondent OMC's unit volume over 75 years, and through Mr. Piper with respect to sales unit volume and advertising expense. This subsidiary issue would be moot in the event of the denial of the Petition.

Respondents' only other comment with respect to the question presented by the Petition is that Respondents believe the Petition is frivolous in view of Petitioner's reliance on Inwood v. Ives, (supra).

STATEMENT PURSUANT TO RULE 29.1

Neither British Seagull Corporation, nor Outboard Marine Corporation, has parent or subsidiary companies, defining "subsidiary" as greater than 50% ownership (and excluding wholly owned subsidiaries).

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
STATEMENT PURSUANT TO RULE 29.1	iii
TABLE OF CONTENTS	iv
TABLE OF AUTHORITIES	v
OPINIONS BELOW	2
JURISDICTION	2
STATUTORY PROVISIONS INVOLVED	2
STATEMENT OF THE CASE	2
REASONS FOR DENYING THE WRIT	16
I. NON-COMPLIANCE WITH RULE 10.1	16
II. THE DECISIONS BELOW ARE NOT IN CONFLICT WITH INWOOD V. IVES	21
III. THE DECISIONS BELOW ARE NOT CLEARLY ERRONEOUS	28
IV. CONSOLIDATION WITH QUALITEX	32
CONCLUSION	33
CERTIFICATE OF SERVICE	35

TABLE OF AUTHORITIES

CASES	Page(s)
In Re Morton- Norwich Products, Inc., 671 F.2d 1332, 1341 (CCPA 1982)	22
Inwood Laboratories v. Ives Laboratories, 456 U.S. 844, 855 (1982)	i, ii, 18, 20-27, 31, 33
Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631, 643 (2d Cir. 1979)	22
Qualitex v. Jacobson Products Co., Inc., 63 U.S.L.W. 3255 (Sept. 26, 1994)	32
Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, (1964)	21
UNITED STATES CODE	
28 U.S.C. §1912	34
RULES OF THE SUPREME COURT	
Rule 10.1	16
Rule 14.1(a)	i
Rule 15.1	2
Rule 29.1	iii
Rule 42.2	34

No. 94-1075

IN THE SUPREME COURT OF THE UNITED STATES

October Term, 1994

BRUNSWICK CORPORATION,
Petitioner,

v.

BRITISH SEAGULL LIMITED
and OUTBOARD MARINE CORPORATION,
Respondents.

On Petition For Writ of Certiorari
To The United States Court of Appeals
For the Federal Circuit

BRIEF IN OPPOSITION

OPINIONS BELOW

JURISDICTION

STATUTORY PROVISIONS INVOLVED

Respondents have no comment on the above three sections of the Petition.

STATEMENT OF THE CASE

The Statement of the Case in the Petition is noteworthy for two reasons:

1) The absence of a fair characterization of the record, i.e. misstatements of facts (Rule 15.1) and

2) Petitioner's reliance on evidence as factual matters in the record, which evidence is the subject of objections which were made and which were not

ruled upon because consideration of such evidence was not prejudicial to Respondents (A000048).

With respect to the absence of a fair characterization of the record, and contrary to the narrow assertion (referring to the absence of testing and survey evidence) at the bottom of page 13 of the Petition, Respondents (Opposers) have presented substantial evidence which supports the findings of the Trademark Trial and Appeal Board (hereinafter TTAB) that (a) color compatibility and perceived size reduction are functional features of the color black, and that (b) the non-availability to competitors (incident to registration) of the color black, including the inherently functional features thereof, would hinder effective competition.

The TTAB noted that there was considerable evidence supporting Respondents' position (A000035)*. "The facts supporting our reasoning are not seriously disputed" (A000034). The Federal Circuit "..discern(ed) no error in the Board's legal reasoning and no clear error in its factual findings" (A000013; A000023).

Specifically, as to the color compatibility of black as an ingredient of a successful marketing program, Respondents offered unrefuted testimony from industry executives and color experts that black outboard motors can be attached to (matched with) boats of any color without risk of clashing with the boat

---

* Numbers in parenthesis (A000000) refer herein and hereafter to the Appendix filed with the Petition.

color because black never clashes with any other color (A000035).

Respondents offered unrefuted evidence as to perceived size reduction by an industry executive (Feurig p. 95 [A002474]*) and by a color expert (Welker p. 82 [A002944]). Furthermore, unrefuted evidence was also offered that boat manufacturers want outboard motors to look smaller so as to be less obtrusive on their boats (A000036). Petitioner's predecessor's former Vice President testified that the reason that the color black was selected by Petitioner's predecessor was the tendency of black to make objects appear to be smaller. (Strang deposition, p. 5 - 6 [A002344 - 002345]).

---

* Numbers in brackets [A00000] refer herein and hereafter to the Appendix filed with the Federal Circuit.

Furthermore, the Petition is silent as to the revolution which is taking place in the marketing of outboard motors. In the past, outboard motors were sold to a wide array of dealers. However, during the late 80's and early 90's, the market was and is moving to large sales of outboard motors to a relatively small number of boat manufacturers and a major retailer who package boats and motors (and trailers) for sale to dealers and to the public (Opp. Confidential Ex. 356, Bates p. 700575, 700646 [A006911 - 006950]; Feurig p. 7 - 8 [A002377 - 002378]). Such boat manufacturers and the major retailer desire black outboard motors to ensure color compatibility with their boats and to reduce the perceived size of the outboard motor so as thereby to maximize emphasis on the boat as a necessary

ingredient to the success of their marketing plans (A000035).

Specifically, Tracker, one of the largest boat manufacturers in the country, demanded black outboard motors for use in its packaged sales of boat and motor combinations (Feurig Ex. 1, p. 28 [A011503 - 011538]; Feurig p. 44 - 45 [A002414 - 002415]). Sears, one of America's major retailers, sells GAMEFISHER brand outboard motors which are black (and which are, at least in part, manufactured by Petitioner) to obtain color compatibility with the colors of its various boats (Burkhardt 11/20/91, p. 196 - 198 and 250 [A002686 - 002688 and A002471]).

As a consequence, Respondents clearly established that, in the unfolding 90's, in order to effectively compete, it is necessary that all outboard motor

manufacturers be able to offer for sale black outboard motors that utilize the dual functional features of color compatibility and perceived size reduction which are being demanded by boat manufacturers and the major retailer. To create, incident to registration of the color black, a monopoly in perpetuity with respect to the color black, and the functional attributes thereof, will impair the ability of all others in the industry to effectively compete.

Further in regard to competitive need, the record also establishes that there are at least fifteen (15) brands of outboard motors, sold by at least eleven (11) manufacturers, most of which outboard motors are painted black or dark colors. Black is one of only five basic colors, and the testimony below is that the "extreme" colors, i.e., pink, red, orange,

etc., are not in use (Hoover p. 17, 21 [A004647, A004651]). Such painting of outboard motors by their manufacturers clearly also indicates that there is competitive need for black outboard motors in the marketplace.

Specifically, the following manufacturers produce black, or primarily black, or darkly colored outboard motors under the indicated brand names:

Manufacturer	Brand Name
Eska	GAMEFISHER
Tanaka	GAMEFISHER
Brunswick	MERCURY* FORCE* GAMEFISHER*
Seagull	SEAGULL
Outboard Marine	JOHNSON TRACKER* EVINRUDE TRACKER EVINRUDE* JOHNSON GT

(Representative physical samples of the outboard motors identified above by

asterisks were marked as exhibits and displayed before both the TTAB and Federal Circuit during oral argument.)

The GAMEFISHER, MERCURY, JOHNSON TRACKER, and EVINRUDE TRACKER outboard motors are black. The FORCE outboard motor is not readily distinguishable from black. (The use of the color black by the FORCE and GAMEFISHER brands, in competition with the MERCURY brand, is in direct conflict with and in derogation of Petitioner's claim to exclusive use (distinctiveness) of the color black as a trademark (A000057)). The SEAGULL outboard motor is primarily black. The EVINRUDE outboard motor is a very dark blue which is nearly indistinguishable from black. Petitioner was unable, during the trial period, to determine whether the color of the JOHNSON GT outboard motor was within the scope of

the black sought to be registered [A003426 - 003438].

Thus, the use by various competing brands of black, primarily black, and dark colors barely distinguishable from black, constitutes additional ample evidence in the record to support the TTAB's finding of competitive need.

The proceedings before the TTAB were fact driven and the TTAB specifically noted that "The facts supporting our reasoning are not seriously disputed" (A000034).

Thus, while Petitioner is correct in the assertion, at the bottom of page 13 of the Petition, that the record does not include evidence with respect to a test or survey with respect to competitive need, there is, as indicated above, ample other persuasive evidence in

the record. The TTAB rejected Petitioner's contention, and noted that Respondents (Opposers) were under no obligation to conduct tests or surveys (A000051).

The statement (at the end of the last full paragraph on page 11 of the Petition) asserting the indisputability of the focus of Mercury's advertisements on "all black" color is incomprehensible in view of the TTAB's specific finding that Petitioner did not effectively image advertise the color black so as to create secondary meaning for black as a trademark (A000055 - 000056).

Contrary to the allegation (at the top of page 13 of the Petition) that the color black "had acquired secondary meaning", the TTAB specifically held, after consideration of at least five factors, that Petitioner had failed to

establish secondary meaning (A000056 - 000061). With respect to the comment on page 13 of the Petition concerning the failure of the Federal Circuit decision to substantially address the issue of secondary meaning (which issue was extensively addressed by the TTAB), no consideration was necessary as the Federal Circuit decision with respect to competitive need rendered moot the issue of secondary meaning, i.e., competitive need precludes registration regardless of the presence or absence of secondary meaning (A000026 - 000027).

The reference (at the bottom of page 12 of the Petition) to two surveys is without merit. One survey is of "record", i.e., part of the ex parte application proceeding, but was never offered or entered into evidence during the inter partes opposition proceeding. As such,

its contents are irrelevant (A000056 - 000061). The other survey is among the evidence to which objections were made. The TTAB concluded that this survey did not establish secondary meaning in the color black, without specifically ruling on the objections made by Respondents (Opposers)(A000052). Most importantly, these surveys are irrelevant to the question of competitive need and solely relate to the issue of secondary meaning, which issue is not before this Court.

The statement beginning at the bottom of page 11 of the Petition is misleading as Petitioner did not initially consider itself entitled to registration of the color black alone. Specifically, Petitioner initially applied for registration of the color black in combination with four specific outboard motor configurations. It was the Examiner

who suggested that the application should be amended to refer solely to the color black.

The Petitioner relies on evidence as to which objection has been made. In the event this Court favorably considers Respondents' (Opposers') objections, the statements (p. 11 and 12 of the Petition) as to the volume of both advertising and sales and the allegations as to Respondent OMC's market share and unit volume over 75 years are without support in the record. Both at the trial level (A000048) and at the appellate level (A000027 - 000028), the decisions did not rule on Respondents' objections only because, on the merits, the decisions were not prejudicial to Respondents.

Furthermore, the TTAB stated that in arriving at its findings, it had

carefully considered all of the offered evidence (A000033 - 000034, A000048).

REASONS FOR DENYING THE WRIT

I. NON-COMPLIANCE WITH RULE 10.1

The Petition does not demonstrate that this case involves "special and important reasons" and that "an important question of federal law" is involved.

Supreme Court Rule 10.1 states, in part, that:

> "A review on writ of certiorari is not a matter of right, but of judicial discretion. A petition for a writ of certiorari will be granted only when there are special and important reasons therefore...."

> "(c) When a state court or a United States court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court..."

The Petition has not alleged any "special and important reasons" for exercise of this Court's discretion to grant certiorari and has not qualified the Petition as involving "an important question of federal law". Specifically, Petitioner's concern for an erroneously perceived "second class" status with respect to color marks (page 17 of the Petition) does not constitute either a "special and important reason" or "an important question of federal law".

The Petition attempts, in reality, to overturn findings of fact which are clearly supported by evidence in

the trial record, i.e., findings of de jure functionality and competitive need. These findings turn on the specific evidence in this case, to which findings the Federal Circuit deferred (A000009). It is particularly noteworthy that Petitioner relies on Inwood Laboratories v. Ives Laboratories, 456 U.S. 844, 855 (1982) wherein the Court held:

> "In reviewing the factual findings of the District Court, the Court of Appeals was bound by the 'clearly erroneous' standard of Rule 52(a), Federal Rules of Civil Procedure. Pullman-Standard v. Swint, ante, p. 273. That Rule recognizes and rests upon the unique opportunity afforded the trial court judge to evaluate the credibility of witnesses and to weigh the evidence. Zenith Radio Corp. v. Hazeltine Research, Inc., 395 U. S. 100, 123 (1969). Because of the deference due the trial judge, unless an appellate court is left with the 'definite and firm conviction that a mistake has been committed,' United States v. United States Gypsum Co., 333 U. S. 264, 295 (1948) it must

> accept the trial court's findings."

As there is no showing of "special and important reasons" and as "an important question of federal law" is not involved, it is respectfully requested that the Petition be dismissed.

The Petition should also be denied for at least the following more specific reasons:

1. The TTAB fully considered and correctly decided the issues (infra, pages 21 - 31).

2. The Petition disputes the evidence and factual findings to which reviewing courts must defer unless clearly erroneous (supra, pages 3 - 16 and 28 - 31).

3. The TTAB's decision, as affirmed by the Federal Circuit is not in conflict with the authority cited by Petitioner (Inwood v. Ives) (infra, pages 21 - 27).

II. THE DECISIONS BELOW ARE NOT IN CONFLICT WITH INWOOD V. IVES

Contrary to the allegation at the top of page 17 of the Petition, the TTAB's "'functionality' conclusion" is not clearly in error, but is amply supported by the evidence referred to herein beginning at page 3.

It is indisputable that granting trademark registration on a color conveys a renewable, and therefore perpetual, monopoly on that color and on any function(s) which that color inherently provides.

Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, (1964) stands for the proposition that maintenance of free and unhindered competition (except when patents and "palming off" are involved, neither of which is present herein) is the

basic business law of the land. Use by competitors of the functional features of a product in furtherance of free and unhindered competition is authorized by law and is to be encouraged for the benefit of the public. "Reproduction of a functional attribute is a legitimate competitive activity." Inwood v. Ives (supra, p. 863). Competitive need arises when a feature is functional, i.e., is needed by competitors, i.e., is "essential to effective competition." Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631, 643 (2d Cir. 1979). It is the effect upon competition, supported by the extensive factual record below in this case, which establishes competitive need and, thus, functionability. In Re Morton-Norwich Products, Inc., 671 F.2d 1332, 1341 (CCPA 1982).

The general test referred to in footnote #10 in Inwood v. Ives (supra, p. 850) has been factually satisfied in this case, i.e., free competition in the marketing of outboard motors is dependent on the color compatibility utility and the perceived size reduction utility of the color black, which features are not available with use of other colors. In effect, the TTAB held below, and the Federal Circuit affirmed, that use of the color black is essential to the use (sale) of outboard motors because without the color compatibility utility and the perceived size reduction utility of black (only available from black), competition by competitors would be hindered (A000012 - 000013; A000022).

Even more significantly, Inwood v. Ives requires, yes, even demands, denial or dismissal of the Petition.

Specifically, on the merits, in Inwood v. Ives, this Court did not reverse, but, indeed, approved, the decision below of the District Court that use of a color (blue) on one drug capsule, and use of a color combination (red-blue) on another drug capsule was de jure functional (without using this term). The following features were confirmed as (de jure) functional by this Court (supra, p. 853) when this Court held:

> In reaching its conclusion, the (district) court found that the blue and blue-red colors were functional to patients as well as to doctors and hospitals: many elderly patients associate color with therapeutic effect; some patients commingle medications in a container and rely on color to differentiate one from another; colors are of some, if limited, help in identifying drugs in emergency situations; and use of the same color for brand name drugs and their generic equivalents helps avoid confusion on the part of those responsible for dispensing drugs. *Id.*, at 399. In addition, because Ives had failed to show that the colors indicated the drug's origin,

> the court found that the colors had not acquired a secondary meaning. *Id.*, at 399. (insert supplied)

These de jure functions are not unlike the color compatibility and perceived size reduction de jure functions in this case.

This Court noted, in Inwood v. Ives (supra, p. 853) that the District Court found that "Ives failed to establish its claim based upon §43(a)", and also held "because Ives had failed to show that the colors indicated the drug's origin ... the colors had not acquired secondary meaning." (supra, p. 853). Similarly, in the case at bar, the TTAB also held that Petitioner had failed to establish secondary meaning (A000056).

Thus, in reality, Petitioner is attempting to improperly set aside factual findings of the TTAB, which findings are clearly supported in the voluminous trial

record, and to drive a linguistic wedge between "competitive need" and "essential to the use or purpose of an article". In this case, that which hinders free and unhindered competition (by monopolizing functional features not otherwise available) is essential to the (effective) use (sale) of outboard motors, because purchasing boat manufacturers and at least one major retailer want these features, and therefore, without such features, free and unhindered competition is necessarily restrained. Thus, this case does not constitute a departure from Inwood v. Ives.

Inwood v. Ives does not support grant of the Petition, but instead, clearly indicates that the decisions below were correct because Inwood v. Ives affirmed de jure functionality (without using that term) and because factual

findings at the trial level must be respected and can only be put aside if clearly in error. The Petition contains no showing of clear error. Contrary to Petitioner's assumption (assertion) that the TTAB applied a "functionality" test more expansively to the Petitioner's application for a color trademark than to other types of federal trademarks, the decision below is in full accord with Inwood v. Ives. Accordingly, Inwood v. Ives clearly calls for denial or dismissal of the Petition. In addition, the dual holding in Inwood v. Ives affirming de jure functionality and requiring that factual findings at the trial level not be disturbed, makes this Petition, based on Inwood v. Ives, frivolous.

III. THE DECISIONS BELOW ARE NOT CLEARLY ERRONEOUS

The comment with respect to competitive need (near the bottom of page 16 of the Petition) represents Petitioner's view of the facts, not that of the TTAB, and totally disregards the movement of the market to boat manufacturers (supra, pages 6 - 8).

With respect to the contention, at page 18 of the Petition, that the TTAB failed to cite the record for specific evidence to support its factual findings, there is no rule of law which requires a trial court to cross reference the record when making findings of fact. The only requirement is that the findings be supported in the evidence. In this case, the findings are clearly supported in the record.

With respect to the evaluation of "credible evidence" made at the middle of page 18 of the Petition, such evaluation is that of Petitioner and not that of the TTAB.

The statement in the Petition, at page 18, that there "was no evidence in the record suggesting Mercury's 'all black' mark is essential for 'effective' competition" is Petitioner's reading of the evidence, and not that of the TTAB. The record clearly supports both the finding of competitive need by the TTAB and the decision of the TTAB, which decision was affirmed by the Federal Circuit (A000022).

In the Petition, at page 13, in the section entitled "PROCEEDINGS BELOW', a portion of the decision of the TTAB is quoted, which portion is only a part of a full paragraph, is taken out of context,

and therefore is misleading. The full paragraph of the decision of the TTAB is set out hereinafter, with omitted portions underlined.

> Opposers pleaded and argued that the color black cannot function as a source indicator for applicant's goods to distinguish them from others because other manufacturers of these kinds of products have used black and other dark colors and have a competitive need to color their goods black. There is considerable evidence offered to support opposers' argument that although the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors. The evidence shows that people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels, and that they also find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats (A000034 - 000035).

Thus, although the TTAB admittedly did not find that the color black made the outboard engine work better or is easier or less expensive to manufacture (which was never contended by either side), the TTAB did make specific factual findings of functionality, which findings are not in the conflict with the finding in Inwood v. Ives.

The Petition should therefore be denied.

IV. CONSOLIDATION WITH QUALITEX

The question presented in the Petition does not bear on the basic issue of the registrability of color, which is the only question accepted by this Court in Qualitex v. Jacobson Products Co., Inc., 63 U.S.L.W. 3255 (Sept. 26, 1994). The question raised herein refers to the issue of preclusion of registrability because of competitive need and functionality, which issue is entirely separate and apart from the basic issue of the registrability of color. Accordingly, Respondents respectively submit that there is no reason for consolidation with Qualitex.

CONCLUSION

Petitioner has failed to demonstrate the presence of any "special and important reasons" and any "important question of federal law" which qualifies this case for a writ of certiorari. Petitioner merely seeks to overturn factual findings clearly supported by the evidence by asserting linguistic differences of no import between the precedent of this Court (Inwood v. Ives) and the reasoning of the decisions below. Petitioner's allegation of conflict with the precedent of Inwood v. Ives is totally erroneous and frivolous. Accordingly, Respondents respectfully request that the Petition be dismissed.

In addition, Respondents respectfully request an award of damages (attorney's fees), interest, and double

costs in view of the frivolous character of the Petition (Rules 42.2, and 28 U.S.C. §1912).

Dated: January 13, 1995

Robert E. Clemency, Esq.*
Lee J. Geronime, Esq.
R. Warren Comstock, Esq.**
Michael, Best & Friedrich
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

*Attorney of Record
**Of Counsel

CERTIFICATE OF SERVICE

The undersigned hereby certifies that three copies of the foregoing **BRIEF IN OPPOSITION** were served via First Class Mail, postage prepaid on this 16th day of January 1995 on the below listed counsel:

Timothy J. Haller
Niro, Scavone, Haller & Niro
181 West Madison, Suite 4600
Chicago, Illinois 60602
(Counsel for Petitioners)

Fred E. McKelvey
2121 Crystal Drive
Suite 918
Arlington, Virginia 22202
(Counsel for the Commissioner of Patents and Trademarks

Robert E. Clemency

State of Wisconsin)
)SS:
Milwaukee County)

Sworn before me this 16th day of January, 1995.

Notary Public, State of Wisconsin

My commission expires: 9-7-97

Supreme Court, U.S.
FILED
FEB 6 1995
OFFICE OF THE CLERK

No. 94-1075

In The
Supreme Court of the United States
October Term, 1994

BRUNSWICK CORPORATION,
Petitioner,

v.

BRITISH SEAGULL LIMITED and OUTBOARD MARINE CORPORATION
Respondents,

Reply Brief In Support Of Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

TIMOTHY J. HALLER*
MICHAEL P. MAZZA
NIRO, SCAVONE, HALLER & NIRO
181 West Madison
Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Attorneys for BRUNSWICK CORPORATION

** Attorney of Record*

Chicago Legal Copies, Inc. (312) 332-7777

No. 94-1075

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1994

BRUNSWICK CORPORATION,

Petitioner,

v.

BRITISH SEAGULL LIMITED
and OUTBOARD MARINE CORPORATION,

Respondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The precise issue is whether the Federal Circuit erred in affirming the finding of the Board that Mercury's "all black" trademark is "functional." The Petition should be granted because the decisions of the Federal Circuit and the Board below cannot stand unless color

trademarks are subject to a more loose or expansive standard than other types of federal trademarks. This special and important question of federal law is as fundamental as the issue of whether a color alone can be registered (Qualitex). It is implicated in every color registration issue, and therefore calls for an exercise of this Court's power of supervision.

The parties are now in agreement on several crucial points. First, the parties agree that a trademark (including color) is "functional" only if its use in connection with a product is found to be "essential to effective competition." (Respondents' Brief In Opposition, at 22).

Second, the parties also agree that the record is devoid of any test data or survey evidence in Respondents' favor on the "competitive need" issue (id., at 11).

The parties disagree on this basic point: Are the Board's two conclusory statements on functionality -- that consumers "like" their

motor colors to match their boat colors (A35)[1], and that they "find it desirable under some circumstances" to reduce the size perception of the motors in relation to the boats (A35) -- sufficient to demonstrate that Mercury's particularized "all-black" color on outboard engines is really essential to effective competition? Respondents say that a feature is "essential" if it merely "hinders free and unhindered competition ... because [unidentified] purchasing boat manufacturers and at least one major retailer want these features ..." (Respondents' Brief, at 26) (emphasis added). The Federal Circuit also says that if use of a color serves "a non-trademark purpose that hinders competition" (A17-A18) (emphasis added), protection is lost.

This reasoning turns the "essential to effective competition" test on its head. Under that reasoning, trademark rights are lost as to any merely desirable feature which then can be

---

[1] References to "A__" are to the Appendix attached to the Petition.

said to "hinder" competition if not available. That cannot be correct. Yet, the Board and Federal Circuit decisions turn on this rationale.

No other explanation is possible, since the evidence of non-functionality was one-sided in Mercury's favor:

(1) Mr. Hawley, owner of the largest multiline boat/engine dealership in the Pacific Northwest, testified that in his extensive selling experience, which includes the sale of both Mercury and OMC engines (App.A.5096-5101[2]), motor color is not the primary factor in a purchase decision (App.A5135); a salesman never told him that they lost a sale of an OMC Johnson motor because it was not Mercury black (App.A5134).

(2) Mr. Hoover, the Vice President of Marketing and Sales for Ranger Boats (a high end boat manufacturer which markets OMC and Mercury motors on its boats, App.A.4634-4639), testified that his company offers more than 25 boat colors, and that the motor color "does not need to coordinate with the boat" and only need fit within a "spectrum of the popular colors" -- more important is motor "quality and performance" (App.A4647-4648, 4654-4655); black does not sell well in those Western or Southern states

---

[2] References to "App.A.___" are to the Appellate Appendix.

where it gets too hot (App.A4654-A4655); and he never heard it said that a non-black motor color is a competitive disadvantage (App. A4633).

(3) Mr. Olson, the Senior Vice President in charge of marketing Bayliner and Maxum boats, testified that motor color is not "a large consideration" in the motor/boat package sale (App. A5172); a customer has never told him that they "wouldn't buy the boat because of the engine color" (App. A5174).

The complete failure by the Board and the Federal Circuit to even acknowledge this third-party evidence is telling.

In stark contrast, Respondents rely on the testimony of Respondent OMC's Director of Sales, Mr. Feurig, and Respondents' color expert, Ms. Welker. But these witnesses merely alleged that black can make a motor look smaller, and is compatible with many colors, not that consumers even want these features, or that other colors do not have these characteristics (App.A2474, A2944). OMC's other testimony on "size perception" comes from OMC's Chairman, Mr. Strang, who testified that when he was Chief Engineer of Mercury in the early 1960's, his

now-deceased mother encouraged him to try coloring a new Mercury engine black to make it look smaller (App.A.2344-2345). As to "a major retailer" wanting black, Mr. Burkhardt of Sears never said that black engines were important to a sale (A2686-A2688).

Petitioner notes that Respondents' numerous statements with regard to secondary meaning (see, e.g., Respondents' Brief, at 9-10, 12-14, 25) are irrelevant here, since the Federal Circuit's decision neither turned on nor reviewed the secondary meaning issue (A27). The statements are also largely incorrect and misleading. For example, Respondents say that it is "incomprehensible" (Respondents' Brief, at 12) that Mercury's advertisements promote its color mark. Yet, even the Board admits that they include a "textbook example of how to promote color as a trademark" (A55).

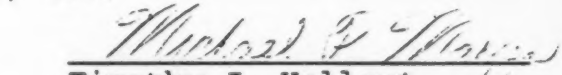
Respondent are also incorrect in their assertion that "the volume of both advertising and sales [of Mercury] and the allegations as to Respondent OMC's market share and unit volume

over 75 years are without support in the record." (Respondents' Brief, at 15). Mercury's advertising and sales volumes are expressly recited in both the Board (A40) and Federal Circuit (A3) opinions. As to OMC's market share data, the Appellate Appendix citation is given in the Petition (at 12 -- A11939-11943). There is also supporting testimony from Mr. Ducoty, Mercury's Director of Strategic Planning (A4216, A4219), and Mr. Hoover (A4663) on this point ("OMC has the dominant market share in the outboard market."). Mercury agrees that Respondents' objections to the introduction of this latter evidence were never ruled on (Respondents' Brief, at 15). However, OMC's attempt to disavow its "dominant" market share, while never offering a commercial all-black engine of its own, is telling.

CONCLUSION

For the reasons set forth both here and in the Petition, it is respectfully suggested that consolidation of this case with the pending Qualitex case would be appropriate. In any event, a writ of certiorari should issue to review the judgment and opinion of the Federal Circuit.

Dated: February 2, 1995



Timothy J. Haller*
Michael P. Mazza
NIRO, SCAVONE, HALLER
& NIRO
181 West Madison Street
Suite 4600
Chicago, Illinois 60602
(312) 236-0733
Attorneys for Petitioner
Brunswick Corporation

*Attorney of Record